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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/669,418

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Jaroslav Sranka

150-129

5062

7590
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EXAMINER

MACARTHUR, VICTOR L

ART UNIT

PAPER NUMBER

3679

MAIL DATE

DELIVERY MODE

12/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/669,418	Applicant(s) SRANKA, JAROSLAV	
	Examiner VICTOR MACARTHUR	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/2009 has been entered.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Sweden on 3/28/2001. It is noted, however, that applicant has not filed a certified copy of the 0101116-2 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Courtot (US 3,026,129) in view of Zeigler (US 6,094,922).

Courtot discloses a swivel comprising a first member (10), shaft (14) fixed (axially) to the first member, second member (5) mounted for rotation on the shaft, such that the second

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member is rotatable relative to the first member; a media transfer member (8) extending between the first and second members; wherein the media transfer member is provided at a spaced location around the circumference of the shaft. Courtot does not expressly disclose additional media members, however:

- Zeigler teaches that it was old in the art for swivels to have multiple media members.
- The knowledge commonly available to one of ordinary skill in the art (one skilled in the design, manufacture, and use of swivels with media members) would include:
 - knowledge that multiple media members will allow for transfer of a larger amount of media than a single member;
 - knowledge that multiple media members will allow for transfer of media in more directions (e.g., feed direction, return direction) than a single media member, and
 - knowledge that multiple media members will allow for media transfer even after failure of a single media member, thereby making multiple members more reliable than a single media member.
- It has generally been recognized that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).
- “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

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- Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from a swivel with multiple media members over a swivel with only a single media member. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04.
- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Courtot to have multiple media members, as taught by Zeigler, with motivation taken from the knowledge of one of ordinary skill in the art to increase the amount of media transfer, increase the possible directions of media transfer, and increase reliability as detailed above. Also even if this were not so, the limitation has no criticality (unexpected result) and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art.
- Note that MPEP section 2144 clearly states “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art... it may be reasoned from **knowledge generally available to one of ordinary skill in the art**, established scientific principles, **or legal precedent established by prior case law**” (emphasis added).

Regarding claim 46, element 17 reads on the “cylindrical housing”.

Regarding claim 49, note that the limitation “quick” is a relative term.

Regarding claim 50, element 15 reads on the “base plate”.

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Applicant argues that Courtot discloses only one media transfer member (8) and does not disclose any additional transfer members. This is not persuasive since it is Ziegler, not Courtot that is relied upon to teach that a plurality of members were old in the art (see reworded rejection above).

Applicant argues that there is no motivation to modify Courtot to have multiple media transfer members, rather than only a single media transfer member. This is not persuasive. As detailed in the reworded rejection above, motivation to modify Courtot, in view of Ziegler, comes from the knowledge commonly available to one of ordinary skill (one skilled enough to design, manufacture, and use swivels with media transfer members) in the art at the time of invention; and also from case law. MPEP section 2144 clearly states “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art... it may be reasoned from **knowledge generally available to one of ordinary skill in the art**, established scientific principles, **or legal precedent established by prior case law**” (emphasis added).

Applicant argues that if Courtot were modified to have additional metal tubings (8) they would not and necessarily could not be provided at spaced apart locations around the circumference of the shaft. This is not persuasive. Ziegler clearly teaches multiple tubings radially spaced from one another and from a central axis of rotation. Accordingly, all evidence indicates that Courtot can be modified to have a multiple tubings radially spaced from one another and from the Courtot shaft which is located at a central axis of rotation. Applicant has

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failed to provide any actual evidence to the contrary. MPEP section 2145 clearly states “The argument of counsel cannot take the place of evidence in the record... An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case of obviousness”. See also MPEP section 716.01(c).

In response to applicant's argument that the prior art is not structurally combinable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

December 14, 2009

/Victor MacArthur/
Primary Examiner, Art Unit 3679